



Appl. No. 09 402 563  
Brief dated September 8, 2003  
Reply to Office action mailed November 29, 2002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**VAN ROMUNDE ET AL**

**SERIAL NO. 09 402 563**

**FILED: OCTOBER 5 1999**

**FOR: SYSTEM AND METHOD FOR  
STEERING INTERRELATED ACTIONS**

**Commissioner for Patents  
Alexandria, VA 22313**

**Art Unit: 2163**

**Examiner: ROBINSON BOYCE**

**Docket No: KOB 10**

**RECEIVED**

**SEP 30 2003**

**GROUP 3600**

**SUBMISSION OF BRIEF ON APPEAL**

Sir:

Applicants enclose a Brief in support of their appeal of the Primary Examiner's Final rejection of claims 1-3, 5-14, 16, and 17. Also enclosed are 1) two copies of the Brief, 2) a Credit Card Payment Form for the applicable fee, 3) a Petition for Extension of Time, and 4) a Credit Card Payment form for the difference between the previously paid fee (\$55) and the fee now due (\$205).

Respectfully submitted,

VAN ROMUNDE ET AL

BY *Maria Parrish Tungol*

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner of Patents, Alexandria, VA 22313 on this 8th day of September 2003.

By *Maria Parrish Tungol*



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APPEAL BRIEF

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GROUP 3600

Sir:

This is an appeal of the Primary Examiner's Final rejection of claims 1-3, 5-14, 16, and 17.

REAL PARTY IN INTEREST

The real parties in interest are the Applicants, Leo K. Van Romunde and Paul Claude Kaiser.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner of Patents, Alexandria, VA 22313 on this 8th day of September 2003

By 2 pcy

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## STATUS OF CLAIMS

Claims 1-3, 5-14, 16, and 17 stand rejected under 35 U.S.C. §102(b) as anticipated by McIlroy et al.

## STATUS OF AMENDMENTS

The Examiner has indicated that the amendment to the specification filed on August 5, 2003 will be entered.

## SUMMARY OF INVENTION

Guideline procedures, i.e., procedures according to a recommended sequence of steps, are considered as an ideal means for managing and controlling quality and costs, especially in medical and welfare activities. The method and computer system according to the invention use a recorded catalogue of recommended actions comprised of hierarchised sequences of alternative actions to assist a professional in implementing guideline procedures in an interactive way. The alternative actions are comprised of sequential procedure steps. The user can elect whether or not to apply the procedure steps and then judge the eventual effect. The method and computer system according to the invention advise the user of the recommended procedure steps and guide the user in implementing the recommended sequence of procedure steps to achieve a defined objective.

In the present invention, electronic evaluation forms are generated as a function of the sequence of actions selected by the user. The evaluation forms are hierarchically organized as forms and subforms. A fundamental feature of the invention is that an hierarchy is assigned to the procedure steps and their related forms. A relation is established between the generated forms and the relationship has a certain order. The generation of particular evaluations forms is also a function of prior actions of the user in the same case.

For example, the method provides technical assistance in the sequential implementation of actions such as medical guideline procedures. When the user selects a particular medical guideline during a consultation, a form is generated that contains recommended diagnostic testing. The doctor is not required to order these tests and may order different or additional testing. After receiving the

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test results, the doctor enters his opinion in a dialogue screen. The next guideline step is determined as a function of the doctor's opinion of the test results. At the next consultation, the system generates an appropriate evaluation form/subform in accordance with the medical guideline.

The hierarchical organization makes it possible to transfer a group of forms, e.g., all of the specific forms used to order tests for one patient, in one operation into one file. When transferring a main form, all related forms are transferred at the same time. In a preferred embodiment, the technical concepts of the invention be implemented by means of Lotus Notes or Lotus Domino Notes software. In Lotus Notes, the group of forms can be transferred to a single folder.

The users of the method can thus create files with any desired content and archive them in any desired manner. The use and effectiveness of the sequence of steps in specific cases can also be evaluated.

In another preferred embodiment of the present invention, the recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions. In another preferred embodiment, these selection algorithms are integrated in the generated evaluation forms.

## ISSUES

Whether the Examiner erred in rejecting claims 1-3, 5-14, 16, and 17 under 35 U.S.C. §102(b) as being anticipated by the disclosure of McIlroy et al..

## GROUPING OF CLAIMS

Applicants submit that claims 1-3, 5-14, 16, and 17 do not stand or fall together. Applicants request consideration of the claims in the following groups:

Group 1: Claims 1, 5-10, 12, 16, and 17 which are the generic claims in the application.

Group 2: Claims 2-3 and 13-14 which are directed to preferred embodiments of the method and computer system of the generic claims. Claim 2 is directed to the method according to claim 1, wherein said at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions. Claim

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3 is directed to the method according to claim 2, wherein the selection algorithms are integrated in the generated electronic forms. Claims 13 and 14 are directed to a computer system and correspond to claims 2 and 3.

Group 3: Claim 11 which is directed to the method according to claim 1 wherein Lotus Notes and/or Lotus Domino Notes is used as the steering software.

The claims of Group 2 are separately patentable because McIlroy et al. do not disclose a recorded catalogue of recommended actions where the recorded catalogue comprises associated selection algorithms in respect of the hierarchised sequences of alternative actions.

The claim of Group 3 is separately patentable because McIlroy et al. do not disclose or suggest the use of Lotus Notes and/or Lotus Domino Notes software to implement the disclosed process.

#### ARGUMENT

**The Examiner erred in rejecting claims under 35 U.S.C. §102(a) since the reference does not disclose all of the elements of the claims.**

The standard for anticipation is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Federal Circuit court decisions repeatedly emphasize that anticipation (lack of novelty) is established only if (1) all the elements of an invention, as stated in a patent claim, (2) are identically set forth, (3) in a single prior art reference. Federal Circuit decisions reject any standard of "substantial identity". "[A] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). ". . . exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference". *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574, 224 USPQ 409, 411 (Fed. Cir. 1984).

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The Examiner erred in rejecting the claims as anticipated under 35 U.S.C. §102 because the Examiner has failed to properly apply the statute in accordance with established case law. For example, claim 11 which is directed to the implementation of the claimed method by Lotus Notes or Lotus Domino Notes stands rejected under 35 U.S.C. §102(b). The cited reference discloses the use of Microsoft C as the application software to implement its process. The reference has *no mention* of Lotus Notes or Lotus Domino Notes as the application software. Yet, even after it was noted that the reference does not disclose Lotus Notes or Lotus Domino Notes, the Examiner maintained the rejection under 35 U.S.C. §102 arguing that “these applications are repeatedly used as steering solutions in the electronic document maintenance art” and “McIlroy already teaches the use of an application program as steering software in Col. 5, lines 43-46, thereby making LOTUS NOTES and/or LOTUS DOMINO NOTES an inherent addition to the claim”.

In maintaining the rejections under 35 U.S.C. §102, the Examiner has mistakenly cited broad generic disclosure such as “application software” and “information” as “anticipating” specific claim limitations such as Lotus Notes and evaluation forms. It is well established that “it is not uncommon that a ‘species’ may be patentable . . . notwithstanding a prior art ‘genus’ ”, *In re Ornitz*, 376 F.2d 330, 336, 153 USPQ 453 (CCPA 1967) and *In re Meyer*, 599 F.2d 1026, 1031-32, 202 USPQ 175 (CCPA 1979) (“The genus, ‘Alkaline chlorine or bromine solution,’ does not identically disclose or describe, within the meaning of § 102, the species alkali metal hypochlorite, since the genus would include an untold number of species.”). Likewise, the generic disclosures cited by the Examiner (e.g., “application software” and “information”) would include a large number of species other than the species of Applicants’ claims.

#### GROUP 1

**McIlroy et al. does not anticipate claims 1, 5-10, 12, 16, and 17 because the reference does not disclose “at least one recorded catalogue of recommended actions” comprised of “hierarchised sequences of alternative actions”.**

Independent claims 1 and 12 recite “at least one recorded catalogue of recommended actions”. In the Final rejection, the Examiner cited certain portions of McIlroy et al. to support her

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position that “at least one recorded catalogue of recommended actions” was disclosed by the reference. The cited section in col. 7, lines 45-53 is a general description of a guideline as a “disciplined framework or process to guide and assist the user . . . in identifying appropriate treatment”. Applicants submit that this general teaching is not sufficient disclosure of a *recorded* catalogue of recommended actions to support the rejection under 35 U.S.C. §102.

In the Final rejection, the Examiner took the position that the question/answer sequence corresponds to Applicants’ “recorded catalogue of recommended actions”. The Examiner cited the disclosure at col. 7, line 54 to col. 8, line 22 which generally describes the question/data collection phase. The other cited teaching at col. 2, line 59 to col. 3, line 3 refers to interactive question and answer methodology and “presenting questions in a logically-structured order, leading to guideline treatment options”.

Applicants submit that the sequence of entry phase, then question phase, followed by the identification of a treatment option or other action is *not* a recorded catalogue of recommended actions comprised of hierarchised sequences of alternative actions. The sequence itself is comprised of fixed phases. There is no alternative to entry phase, the question phase or the treatment option phase. The system of McIlroy et al. will always proceed through these phases even though there may be additional questions in the question phase or further review in the treatment option phase. These additional steps are extensions of, not alternatives to the required phases.

The entry phase collects information from the user. No recommended actions or alternative actions are present in this phase. Therefore, Applicants’ claimed “catalogue of recommended actions comprised of hierarchised sequences of alternative actions” is not readable on the entry phase of McIlroy et al.

The question/data collection phase does not involve any recommended actions or sequences of actions. Questions are presented to the user and data is collected from the user. Neither the questions nor the data is an action. Therefore, the question/answer sequence is neither a catalogue of recommended *actions*, nor a “hierarchised sequences of alternative *actions*”. The user of the system of McIlroy et al. is first presented with a question which is not an action. Depending upon the

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answer, the user is then presented with a choice of guidelines or more questions neither of which are actions.

The sequence of selections or answers made by the user are created at the time of use and are not in any *recorded* catalogue prior to selection by the user. Therefore, the sequence of selections by the user in McIlroy et al. is not a disclosure of a *recorded* catalogue of recommended actions which is used to steer a process of interrelated actions. Any recordation of the sequence takes place *after* the selection and is not used thereafter to steer the process.

In the Final rejection, the Examiner also relied on the teaching in col. 5, lines 21-45 that a guideline viewed as a decision tree with multiple data collection nodes and conditional branching. Again, this general teaching is not a disclosure of any recorded catalogue of recommended actions. The decision tree is a way of illustrating the logic used to arrive at the treatment options. The decision tree itself is *not* actually recorded in the system and is *not* a catalogue of recommended actions.

In the Advisory action, the Examiner maintained the rejections under 35 U.S.C. §102 arguing that :

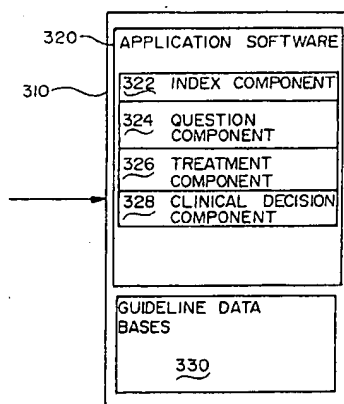
As presented by McIlroy, this guideline must be a step by step algorithm that can be coded, therefore making it recordable. In addition, these guidelines of McIlroy present an assessment phase and a final recommendation phase, which present recommendations to the patient.

Although it is disclosed that each guideline has “a definite algorithmic structure”, McIlroy et al. do *not* disclose that the algorithm is actually coded (“algorithm that *can* be coded”, col. 7, line 48). Applicants submit that the algorithmic structure is not recorded as code in the application software. As disclosed in col. 6, line 10 to col. 7, line 25, the algorithmic structure is built into the design and structure of the question and answer databases and the relationship between them. Therefore, the Examiner’s position that the algorithm is coded and therefore is a retrievable record is not supported by the reference or any other evidence in the record.



It also appears that the Examiner is contending that the “coded” algorithm of the guideline is “comprised” of “an assessment phase and a final recommendation phase” which correspond to the “recommended actions” of Applicants’ claims. With regard to the “assessment phase” which is presumably the question/answer phase, Applicants submit that the questions and answers in the database items in Figs. 2, 4, 5, etc. are not actions. Therefore, the disclosure of an “assessment phase” (question/answer phase) is not a disclosure of “at least one catalogue of recommended actions” which is an element of Applicants’ claims.

Applicants submit that the only recorded catalogue of recommended actions in the method of McIlroy et al. is the list of treatment options shown in Fig. 7 as a guideline database item. The application software is not comprised of the lists in the database since the reference shows that the application software, 320, is separate from the guideline databases, 330 as shown below.



The list of treatment options in “a final recommendation phase, which present recommendations to the patient” (Figs. 15 and 16) is comprised of treatment options retrieved from the list in the guideline database. However, the list in Figs. 15 and 16 is only displayed. There is no evidence that this particular list is actually recorded. Therefore, “at least one recorded list of recommended actions” is not readable on the list of final recommended treatments of McIlroy et al. in Figs. 15 and 16.

The catalogue of recommended actions of Applicants’ claims is comprised of hierarchised sequences of alternative actions. The treatment options as shown in Fig. 7 are not listed as

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“hierarchised sequences of alternative actions”. There is no indication of any hierarchy in the list of the alternative actions in Fig. 7. Likewise, there is no teaching that the treatment options in Figs. 15 and 16 are listed in order of preference.

In the Advisory action, it appears that the Examiner has taken the position that “hierarchised sequences of alternative actions” is readable on the list of treatment options as in Figs. 15 and 16 in “a final recommendation phase, which present recommendations to the patient”. The Examiner argued that:

As per the hierarchised sequence of alternative solutions, this limitation is discussed in McIlroy et al. in Col. 5, lines 11-20 where it discloses that alternative treatments can be determined based on user identifiable patient characteristics specific to that patient. Since these alternative treatments are determined as the user is guided through the logical sequence of questions related to specified health care conditions, the alternative treatment recommendations are therefore directed towards the healthcare condition of the patient and are presented in accordance with the best treatment match per condition and **therefore the most valuable treatments will be presented first.** (emphasis added)

As noted previously, the list of recommended treatment options is not recorded. Furthermore, McIlroy et al. do not teach that the recommended treatment are presented in a hierarchical manner. The reference discloses that the recommended treatments are “highlighted” (col. 12, lines 47-48 and col. 13, line 1). There is no support for the Examiner’s conclusion that “therefore the most valuable treatments will be presented first” (“anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product”, *Ex parte Standish*, 10 USPQ2d 1454, 1457 (Bd. Pat. App. & Int’f 1989)).

Although the recommended treatments in Figs. 15 and 16 appear at the top of the list, there is no teaching that this is always the case. Applicants submit that the identification of the preferred options on the screens in Figs. 15 and 16 is evidence that the recommended treatments may not always appear at the start of the list.

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**McIlroy et al. do not disclose evaluation forms that are hierarchically organized as forms and subforms.**

It is known in the art that the term “subform” means a form that can be embedded within a main form. As shown below in the Access database program, the main form and subform are viewed simultaneously by the user.

The screenshot shows the Microsoft Access application window. The main form, titled 'Customers', contains fields for Customer information: CusID (1), Contr (Adams), City (San Francisco), Posts (94117), Contr Owner ( ), Fax (415), Comp (ABC Corp), Billing (87 Park St, Suite 5), State (CA), Coun (USA), and Phone (415) 55. Below the main form are two subforms. The first subform, titled 'Orders', displays a table of orders with columns: OrderID, CustomerID, EmployeeID, OrderDate, PurchaseOrd, and Ship. It shows three records for ABC Corporation. The second subform, titled 'Order Details', displays a table of order details with columns: OrderID, OrderDet, ProductID, Quantity, Order Details Unit Price, Product Unit Price, and Discount. It shows two records for the first order. Navigation buttons for each form are visible at the bottom of the window.

OrderID	CustomerID	EmployeeID	OrderDate	PurchaseOrd	Ship
1	ABC Corporation	Ajar, Denis	2/2/95 52	ABC Corp	
2	ABC Corporation	Ajar, Denis	3/14/96 52	ABC Corp	
3	ABC Corporation	1st Anita	4/28/97	ABC Corp	

OrderID	OrderDet	ProductID	Quantity	Order Details Unit Price	Product Unit Price	Discount
1	3	Basketball	21	\$4.95	\$4.95	0.00
1	4	Football	2	\$5.55	\$5.55	0.00

When a subform is changed, all of the form containing that subform automatically reflect the changes. The difference between a subform and a regular form is that a subform can be inserted into other forms. The subform will behave and appear to the end user as if it were an integral part of the form. In the method according to the invention, a subform can be integrated into several forms (page 6, lines 11-13 of the published application).

McIlroy et al. do not disclose any subforms. The Examiner's position in the Final rejection and the Advisory action that Figs. 10 and 11 show the generation of a subform is incorrect. The Examiner's contention that "Fig. 11 comes from and is embedded in Fig. 10 since clicking on a specific element in the Fig. 10 form results in the Fig. 11 form" is incorrect. The forms are linked, not embedded as shown above. The form of Fig. 11 is *not* a subform of the form of Fig. 10 since the

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user must click on a button to view the form in Fig. 11. Fig. 16 does not show a subform. Fig. 16 is accessed from the screen in Fig. 15 via the "Enter" menu at the top (col. 13, lines 32-34).

The Examiner's statement that "these forms are in a windows format, therefore, one must not view them separately" is contrary to the disclosure of McIlroy et al. and not supported by common knowledge of the Windows environment. Forms and windows can be and usually are viewed separately.

**McIlroy et al. do not disclose the generation of evaluation forms for each sequential procedure step of the hierarchised alternative actions.**

As discussed previously, the entry phase and questions phase do not involve recommended or alternative actions, only data collection and presentation. The forms generated during these phases do *not* correspond to the forms and subforms generated in the claimed method. The treatment option phase of McIlroy et al. presents alternative actions but they are not recorded. Furthermore, the system does not generate any forms for each sequential steps of a treatment option. For example, in Fig. 16, treatment 2B) includes two procedural steps. The method of McIlroy et al. does not generate any evaluation form for these procedural steps. The method according to the invention could generate a form to actually order and schedule the treatment with streptokinase or urokinase and a form to order and schedule treatment with heparin for 6 days after the initial 3 day treatment.

**McIlroy et al. do not disclose the generation of evaluation forms in function of the hierarchised sequences of alternative actions.**

For the reasons discussed previously, Applicants submit that neither the entry phase and question phase of McIlroy et al. correspond to a sequence of alternative actions. Neither phase is comprised of sequences of alternative actions. Applicants submit that the questions and answers in the database items in Figs. 2, 4, 5, etc. are not actions. Therefore, the disclosure of an "assessment phase" (question/answer phase) is not a disclosure of "at least one catalogue of recommended actions" which is an element of Applicants' claims. Therefore, the Examiner's contention that "it has been disclosed that the question component is a recorded catalogue of recommended actions/hierarchised sequence of alternative actions" in the Advisory action is *not* supported by the reference. Likewise, the Examiner's contention that "then the generation of evaluation forms in

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function of the past history of actions in Col. 6, line 64-Col. 7, line 6 of McIlroy et al. is valid" in the Advisory action is incorrect since questions and answers are not actions.

In the Advisory action, the Examiner argued that "Fig. 9B shows that during the therapeutic (sic) selection phase, there are multiple forms generated for each step during the phase". Applicants submit that the therapeutic selection phase includes the questions/answer phase as well as the treatment options. McIlroy et al. does not disclose the generation of forms as a function of the treatment options. For example, no forms are generated for the two steps in treatment 2B) in Fig. 16.

Applicants submit that the only sequences of alternative actions in McIlroy et al. are the treatment options retrieved by the system as in Fig. 15. The treatment options are the endpoints of the process of McIlroy et al. (col. 5, lines 24-26) and are *not* recorded so the list is not a "recorded catalogue". Moreover, no forms are generated as a function of the treatment options. Figs. 10-11 are generated by the user's answers to questions, not by any procedure steps of the treatment options. Therefore, the reference does not teach the generation of evaluation forms in function of the treatment options.

**McIlroy et al. do not disclose the generation of evaluation forms in function of the past history of actions.**

The Examiner has taken the position that generation of evaluation forms in function of the past history of actions is disclosed in col. 6, line 64 to col. 7, line 6 which describes Fig. 6 "in which the answer to a preceding question together with the answer to the current question defines the next step". As discussed previously, the question component is comprised of questions and answers which are not actions. Therefore, the question component is not a recorded catalogue of recommended actions or a hierarchised sequence of alternative actions. According to Applicants' claims, the generation of the evaluation forms is carried out in function of 1) the hierarchised sequences of alternative actions of the recorded catalogue actions *and* 2) the past history of actions. Since the cited disclosure does not disclose 1), Applicants submit that the cited disclosure does not support a rejection under 35 U.S.C. §102 for this aspect of the claimed method.

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**McIlroy et al. do not disclose the transfer of a group of evaluation forms and subforms in one operation into one file.**

In the Final rejection, the Examiner took the position that “McIlroy discloses that the transferring of a group of the evaluation forms and sub-forms using one operation into one file takes place” in col. 18, line 59 to col. 19, line 8. It is again noted that McIlroy et al. do not teach or suggest subforms (forms embedded in other forms). Since subforms are not disclosed, the capability of transfer into one file is certainly not disclosed.

The section of the reference cited by the Examiner describes Fig. 29 which is an example of report sorted by guideline, proposed treatment and final recommendation. The report shows the number of cases under each category, percent specialist review, percent with extensions, etc. The Examiner contends that an “aggregate of the recommendation treatments are disclosed. This operation would be analogous to aggregating the information taken from the forms and sub-forms since the information taken from the forms and sub-forms are evaluated and lead to recommendation treatments”.

As recognized by the Examiner, it is the information (data) from the forms that appears in the report of Fig. 29. In the Advisory action, the Examiner cited col. 11, lines 52-67 of McIlroy et al. as disclosing “that all **information** on a patient according to a selected guideline is in a single file” (emphasis added). There is nothing in the reference that teaches that the forms are capable of being transferred into one file in one operation.

Applicants submit that the generic disclosure of information or data does not anticipate forms and subforms. Even if one assumes that Figs. 10-17 are evaluation forms, there is nothing in McIlroy that teaches or suggests that the forms shown in Figs. 10-17 could be transferred into one file in one operation. There is no disclosure of that these forms could be transferred at all. Therefore, the cited section of McIlroy et al. does not support the rejection under 35 U.S.C. §102 for this aspect of the claimed method.

Applicants have previously presented the detailed reasons why McIlroy et al. do not anticipate independent claims 1 and 12. Therefore, the remaining claims in Group 1 which depend on claims 1 and 12 are not anticipated by McIlroy et al.

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## GROUP 2

### **McIlroy et al. do not disclose electronic selection algorithms in respect of the hierarchised sequences of alternative actions.**

Claim 2 relates to a method according to claim 1, wherein said at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions. The Examiner cites the disclosure at col. 3, line 2-4 to support the rejection under 35 U.S.C. §102. The cited section of the reference states that the interactive question and answer methodology “guides the user through the complex medical evaluation process. . . . by presenting questions in a logically-structured order, leading to guideline treatment option(s)”.

Applicants submit that the “logically-structured order” used in McIlroy et al. are not part of any catalogue of recommended actions. As discussed previously, questions are not actions so the catalogues (list) of questions in Figs. 4-6 are not catalogues of recommended actions. There are no algorithms in the lists shown in Figs. 4-6. The logical order of the questions and answers are the result of the design and the relationship between the lists of questions and answers.

In the Advisory action, the Examiner argues that “in McIlroy, the user selects the guideline which is disclosed as a definite step by step algorithm in col. 7, lines 45-50”. Claim 2 states that the “at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions. As discussed previously, the algorithm of the guidelines is *not* coded so the algorithm does not meet the limitation of being a recorded catalogue of recommended actions. There is nothing in McIlroy et al. that teaches or suggests that the list of recommended actions shown in Fig. 7 comprise associated algorithms in respect of hierarchised sequences of alternative actions. As noted previously, there is no indication of any hierarchy in the list of the alternative actions in Fig. 7. Likewise, there is no teaching that the treatment options in Figs. 15 and 16 are listed in order of preference.

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**McIlroy et al. do not disclose electronic selection algorithms in respect of the hierarchised sequences of alternative actions.**

Claim 3 is directed to another embodiment which is a method according to claim 2, wherein said selection algorithms are integrated in said generated electronic forms. The Examiner cites Figs. 10-17 as disclosing selection algorithms integrated in electronic forms. The Examiner did not provide any explanation how these figures show selection algorithms integrated in electronic forms. In *Ex parte Levy*, 17 USPQ2d 1461, 1462 (Bd. Pat. App. & Int'l 1990) the Board held that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference". Fig. 10-17 do not contain any disclosure of having integrated algorithms.

Applicants submit that Figs. 10-17 do not disclose any algorithms integrated in the forms shown in these figures. The "logically-structured order" of McIlroy et al. is in the design of the database (col. 6, lines 56-63), not in the forms of Figs. 10-17. There is no support in McIlroy et al. for the Examiner's position that this aspect of the claimed invention is anticipated by the reference.

**GROUP 3**

**McIlroy et al. do not disclose or suggest the use of Lotus Notes or Lotus Domino Notes software.**

Claim 11 is directed to a method according to claim 1, wherein the steering software is an application embodiment of commercial LOTUS NOTES and/or LOTUS DOMINO NOTES software. McIlroy et al. disclose the use of Microsoft C as the application software to implement its process. The reference has *no mention* of Lotus Notes or Lotus Domino Notes as the application software. Yet, even after it was noted that the reference does not disclose Lotus Notes or Lotus Domino Notes, the Examiner maintained the rejection under 35 U.S.C. §102 in the Advisory action arguing that "these applications are repeatedly used as steering solutions in the electronic document maintenance art" and "McIlroy already teaches the use of an application program as steering software in Col. 5, lines 43-46, thereby making LOTUS NOTES and/or LOTUS DOMINO NOTES an inherent addition to the claim". Assuming that the Examiner means an addition to the reference,



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Applicants submit that there is no evidence to support the Examiner's position. McIlroy et al. specifically teaches the use of Paradox as the data management software (col. 4, lines 65-66). There is no disclosure of any other database management program. The disclosure of application software generally is not sufficient to support a rejection under 35 U.S.C. §102.

Applicants note that there is no teaching that another data base management software product would be suitable. There is nothing in the reference that would motivate one to use Lotus Notes or Lotus Domino Notes as the data management software. Therefore the Examiner's position that the "use of LOTUS NOTES and/or LOTUS DOMINO NOTES as the application program therefore does not make the claim patentably distinct" is erroneous.

Applicants submit that the Examiner erred in rejecting the claims as anticipated under 35 U.S.C. §102 because the Examiner has failed to properly apply the statute in accordance with established case law. Reversal of the Examiner's rejections under 35 U.S.C. §102 is respectfully requested.

Respectfully submitted,

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## APPENDIX

### **GROUP 1: Claims 1, 5-10, 12, 17, and 17 which are the generic claims in the application.**

Claim 1. Method for electronically storing, retrieving and/or modifying records using a computer system comprising a display unit, an input unit, a memory unit and a processing unit, and involving at least one recorded catalogue of recommended actions, and for sequentially steering a process of interrelated actions from said at least one recorded catalogue of recommended actions, wherein said at least one recorded catalogue of recommended actions comprises hierarchised sequences of alternative actions, wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms, wherein said evaluation forms comprise a list of recommended actions, information-input requests and/or decision-requests, and wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, and in function of the past history of actions so as to enable transfer of a group of evaluation forms and subforms in one operation into one file.

Claim 5. Method according to claim 1, wherein said evaluation form comprises information from records relevant for a decision-request involved in said evaluation form.

Claim 6. Method according to claim 1, wherein a record of information entered and used is stored in said memory unit.

Claim 7. Method according to claim 1, wherein a record of the information and actions entered and used is stored in the memory unit for the purpose of measurement of the effectivity and/or efficiency of effects and/or results of the procedure.

Claim 8. Method according to claim 1, wherein the method involves a supervising organization for the purpose of quality control and quality improvement of the method.

Claim 9. Method according to claim 1, wherein the method allows for updating of the recorded catalogue(s) of recommended actions.

Claim 10. Method according to claim 7, wherein said supervising organisation evaluates the effectivity and/or efficiency of effects and/or results based on said records of information and

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actions used/entered, stored during use of the method, and up-dates the recorded catalogue(s) of recommended actions in function of said evaluation.

Claim 12. Computer system for electronically storing, retrieving and/or modifying records and for sequentially steering interrelated actions in respect of said records, comprising a display unit, an input unit, a memory unit and a processing unit, wherein said memory unit of the computer system comprises at least one recorded catalogue of recommended actions involving hierarchised sequences of alternative actions, and wherein said processing unit of the computer system is programmed to generate electronic evaluation forms, hierarchically organized as forms and subforms, comprising a list of recommended actions, information-input requests and/or decision-requests, in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, and in function of the past history of actions, so as to enable transfer of a group of evaluation forms and subforms in one operation into one file.

Claim 16. Computer system according to claim 12, wherein the processing unit of the computer system is programmed to integrate into the evaluation form information from the records which is relevant for a decision-request involved in said evaluation form.

Claim 17. Computer system according to claim 12, wherein the processing unit of the computer system is programmed to store a record of the information entered and actions used into the memory unit of the computer system.

**GROUP 2: Claims 2-3 and 13-14 which are directed to preferred embodiments of the method and computer system of the generic claims wherein said at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions and wherein the selection algorithms are integrated in the generated electronic forms.**

Claim 2. Method according to claim 1, wherein said at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions.

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Claim 3. Method according to claim 2, wherein said selection algorithms are integrated in said generated electronic forms.

Claim 13. Computer system according to claim 12, wherein said at least one recorded catalogue of recommended actions in the memory unit of the computer system comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions.

Claim 14. Computer system according to claim 13, wherein the processing unit of the computer system is programmed to integrate said selection algorithms into said generated electronic forms.

**GROUP 3: Claim 11 which is directed to the method according to claim 1 wherein Lotus Notes and/or Lotus Domino Notes is used as the steering software.**

Claim 11. Method according to claim 1, wherein the steering software is an application embodiment of commercial LOTUS NOTES and/or LOTUS DOMINO NOTES software.